UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,098	09/29/2000	Hossein David Akhond	004860.P1738C	2656

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER
LAO, SUE X

ART UNIT	PAPER NUMBER
2126	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 September 2000</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-34</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9, 11-13, 15-19, 21, 23-32</u> is/are rejected.

7)☐ Claim(s) <u>10,14,20,22,33 and 34</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 September 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2.   Claims 1-34 are presented for examination.

3.   Applicant filed an IDS on 1/17/2001 which included only copies of PTO-892. Prior art references need to be listed in an PTO-1449 for examiner's acknowledgment of consideration of such references.

4.   The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum,* 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi,* 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman,* 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.   Claims 1-9, 11, 15, 17, 23, 25, 26-32, 34 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,173,337 to Akhond et al. Although the conflicting claims are not identical, they are not patentably distinct from each other. In particular, as to claim 1, U.S. Patent No. 6,173,337 teaches a computer-related method for processing, with a preferred processing application program (preferred electronic mail processing application program) having a preferred identifier (preferred identifier), an event (event) associated with an object (object) generated by a dedicated creator application program (dedicated creator electronic mail application program) having a dedicated identifier (dedicated identifier), the method comprising: causing a relay application program (relay application program) to assume the dedicated identifier (having the dedicated identifier); intercepting (intercepting) the event (event) with the relay application program; and forwarding (forwarding), with the relay application program, the intercepted event to the preferred processing application program, wherein the event would otherwise be directed to a dedicated processing application program having the dedicated identifier. See U.S. Patent No. 6,173,337, claim 1, lines 1-15.

As to claim 2, U.S. Patent No. 6,173,337 teaches (see claim 2, lines 1-6) identifying the preferred processing application program; launching the preferred processing application program; and sending the intercepted event to the preferred processing application program.

As to claim 3, U.S. Patent No. 6,173,337 teaches (see claim 3, lines 1-6) installing the relay application program; installing a selection application program; and selecting, with the selection application program, the preferred processing application program.

As to claim 4, U.S. Patent No. 6,173,337 teaches (see claim 4, lines 1-3) identifying the preferred an application program has a creator type and the dedicated identifier

corresponds to a first creator type of the dedicated processing application program. See claim 4, lines 1-3.

As to claim 5, U.S. Patent No. 6,173,337 teaches (see claim 5, lines 1-3) the preferred identifier corresponds to a second creator type of the preferred processing application program.

As to claim 6, U.S. Patent No. 6,173,337 teaches (see claim 6, lines 1-3, 6-11) receiving an install command; changing the creator type for all application programs having the first creator type to a third creator type; placing the relay application pram in condition for launching at a predetermined time; and providing user accessibility to the selection application program via a selection graphic user interface (GUI).

As to claim 7, U.S. Patent No. 6,173,337 teaches (see claim 5, lines 1-2) system initialization time.

As to claim 8, U.S. Patent No. 6,173,337 teaches (see claim 5, lines 1-4) placing the relay application program into a memory (first location).

As to claim 9, U.S. Patent No. 6,173,337 teaches (see claim 5, lines 1-4) placing the selection application program into a memory (second location).

As to claims 11, 17, note discussion of claims 1 and 3. Processor, memory, display and I/O system would have been inherent.

As to claim 15, note discussion of claims 1 and 6.

As to claim 23, note discussion of claim 3.

As to claim 25, note discussion of claim 1.

As to claims 26-32, 34, note discussions of claims 2-9, respectively.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 4, 6, 28, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites "method of claim *1*" in line 1 and claim 6 recites "method of claim 5 wherein installing said relay application program" in lines 1-2. There is insufficient antecedent basis for the latter limitation in the claim. For the purpose of art rejection, these are interpreted as claim 4 reciting "method of claim *3*" in line 1 and claim 6 reciting "method of claim 5 wherein installing said relay application program" in lines 1-2, as best understood and as they appear to be.

Claims 28 and 30 correspond to claims 4 and 6, respectively. Claim 28 recites "medium of claim *25*" in line 1 and claim 30 recites "medium of claim 29 wherein installing said relay application program" in lines 1-2. There is insufficient antecedent basis for the latter limitation in the claim. For the purpose of art rejection, these are interpreted as claim 28 reciting "medium of claim *27*" in line 1 and claim 30 reciting "medium of claim 29 wherein installing said relay application program" in lines 1-2, as best understood and as they appear to be.

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1, 2, 4, 5, 25, 26, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trissel et al (U S Pat. 5,274,815) in view of IBM TDB ("Tracing the Exported Entry Points in an OS/2 Dynamic Link Library").

As to claim 25, Trissel teaches relay application (modifying program), dedicated creator application / dedicated processing application (target program), and executable instructions for

intercepting (intercept), with the relay application (modifying program), an event (reads, writes) associated with an object (code/instruction) generated by the dedicated creator application (target program), and

forwarding (branch/jump to), with the relay application, the intercepted event to a preferred processing application (surrogate code, col. 6, lines 35-46), wherein the event would otherwise be directed to the dedicated processing application [It is noted that without the interception the reads/writes would be processed by the unmodified target program.]. See col. 10, lines 5-24, 56-68; col. 11, lines 1-20; fig. 6.

Storing the executable instructions onto computer readable medium would have been obvious. Trissel does not teach causing the relay application to assume a dedicated identifier for a dedicated creator application / dedicated processing application.

IBM teaches event (call) interception and processing, wherein an intercepting relay application (MYTRACE) assumes a dedicated identifier (MYTRACE is re-named IBMAPPL) for a dedicated creator application / dedicated processing application (IBMAPPL). See page 2, 2nd para.. Therefore, it would have been obvious to cause the relay application of Trissel to assume a dedicated identifier for a dedicated creator application / dedicated processing application. One of ordinary skill in the art would have been motivated to combine the teachings of Trissel and IBM because this would have provided a mechanism to monitor performance of the target program in a more user friendly fashion by not requiring a user to have detailed knowledge of the source code (IBM, page 1, 1st para.), which is desirable in Trissel (Trissel, col. 2, lines 21-22).

As to claim 1, note discussion of claim 25.

As to claims 2, 26, note discussion of claim 25 for sending/forwarding. Trissel further teaches identifying the preferred processing application program (find instructions that require modification by surrogate code), launching the preferred processing application program (create surrogate code). See col. 10, lines 5-24; col. 11, lines 1-20.

As to claims 4, 5, 28, 29, Trissel as modified teaches (IBM) an application program has a creator type (IBMAPPL, MYTRACE) and the dedicated identifier corresponds to a first creator type (IBMAPPL) of the dedicated processing application program, the preferred

identifier corresponds to a second creator type (MYTRACE) of the preferred processing application program. See entire text of IBM reference.

10.   Claims 3, 11-13, 15-19, 21, 23, 24, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trissel et al in view of IBM TDB as applied to claims 1, 25 and further in view of Root (U S Pat. 5,606,674).

As to claims 3, 27, Trissel teaches installing the relay application program (activate modifying program, col. 4, lines 50-66). Trissel does not teach installing a selection application program and selecting, with the selection application program, the preferred processing application program.

Root teaches event relaying (ink data redirecting), including installing a selection application program (generate redirector window/program) and selecting with the selection application program (user selects via redirector window), a preferred processing application program (target program) to receive event data. See col. 10, lines 22-37. Therefore, it would have been obvious to install a selection application program with which the preferred processing application is selected. One of ordinary skill in the art would have been motivated to combine the teachings of Trissel as modified with Root because this would have provided portability of data structures according to a particular metaphor to the preferred processing application / target program that does not support that particular metaphor (Root, col. 2, lines 44-49), a feature desirable to Trissel (col. 9, liens 24-58).

As to claim 11, note discussion of claim 25 and the equivalence of preferred processing module / preferred processing application, dedicated creator module / dedicated creator application, module for relaying / relay application, dedicated processing application module / dedicated processing application. Further note claim 3 for module for selecting / selection application program. Trissel further teaches memory (14), processor (12), I/O system (I/O ports), and Root teaches display (105). Trissel as modified teaches (Root) module for selecting (redirector window/program) used to select a preferred processing module (target program) (col. 10, lines 22-37). See discussion of claim 3 for detailed discussion. The module for selecting would have been logically coupled to the

preferred processing and the relay modules in order to interact with and to perform its selection service for the relay module.

As to claim 12, Trissel as modified teaches (Root) a module for relaying receives a preferred module identification signal from the module for selecting (user selected target program) (see discussion of claim 3).

As to claim 13, Trissel teaches the relay program activating the preferred processing module (create surrogate code, See col. 10, lines 5-24; col. 11, lines 1-20).

As to claim 15, note discussions of claim 25 for relay application program, claim 3 for selection application program, and claim 3 for installing the relay application program and the selection application program. Note discussion of claim 25 for assuming a dedicated identifier.

As to claim 16, Trissel teaches using an operating system program (control program) to activate (load) a relay application program. See col. 3, lines 50-64; col. 5, lines 8-14.

As to claim 17, it corresponds to claim 11 and thus note claim 11 for discussion.

As to claim 18, Trissel as modified teaches installing the module for relaying (activate modifying program, Trissel, col. 4, lines 50-66) and installing the module for selecting (generate redirector window/program, Root, col. 10, lines 22-37.) (See discussion of claim 3). It is noted that for the installation module to install/load the module for relaying and the module for selecting, the installation module would necessarily need to be coupled to the two modules.

As to claim 19, IBM teaches the relaying module/program (MYTRACE) is implemented in a DLL format (MYTRACE.DLL). See discussion of claim 25 for detail. The selection module/program provides an integral part of the relaying/redirecting function, and therefore it would have been obvious to also implement the selection module/program in a DLL format. A DLL (dynamic link library), by definition, is loaded/installed when needed and unloaded/de-installed/de-coupled when no longer needed. Accordingly, it would have been obvious to decouple the module for relaying and the module for selecting when they are no longer needed.

As to claim 21, note discussion of claim 19.

As to claim 23, note discussion of claim 18.

As to claim 24, note discussion of claim 19.

11.   Claims 10, 14, 20, 22, 33, 34 would be allowable if rewritten to overcome the respective rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the respective base claims and any intervening claims.

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (703) 305-9657. A voice mail service is also available at this number. The examiner's supervisor, SPE John Follansbee, can be reached on (703) 305 8498. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for After Final communications, (703) 746-7239 for Official communications and (703) 746-7240 for Non-Official/Draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Sue Lao

December 12, 2003